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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,639	01/08/2001	Carmel Soffer	P-1660-US	8906

7590 12/29/2003

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EXAMINER

EWART, JAMES D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 12/29/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

TS

Office Action Summary

Application No.

09/674,639

Applicant(s)

SOFFER ET AL.

Examiner

James D Ewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

1. The applicants arguments regarding prior art rejections under 35 U.S.C. 103(s), filed November 7, 2003, have been fully considered by the Examiner, but are not persuasive.

2. Although having a live telephone connection is a valid argument and is distinguishable from prior art cited, examiner does not find anything in the claim indicating that it is a live telephone connection. Joong et al teaches distributed storage and delivery of data associated with cellular telephone network supported subscriber data services (such as short message, facsimile, voice mail and electronic mail delivery) that is achieved *via a telephone connection* (See Figure 1).

3. Regarding a unified path in which a single data packet channel carries both the data and the voice path, as indicated on page 10, Lines 17-19 of amendment B, Examiner does not find anything in the claims indicating a single data packet channel that carries both the data and the voice path. The claims only indicate making a voice and signaling connection between the first and second nodes. Joong et al teaches a received subscriber data message is routed for storage and subsequent forwarding, not to a "home" message center conventionally provided for an addressee subscriber mobile station, but instead to a message center optimally positioned with respect to the subscriber mobile station or associated with an initially receiving mobile switching center. In a second embodiment a mailbox established for a given subscriber mobile station in the home message center is given an optional portability characteristic implemented when the owning subscriber mobile station is roaming. In such cases, the roaming subscriber mobile

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station may instruct the establishment of a local mailbox in a proximate message center. There is nothing in Joong et al that discusses a that the CLI is often lost, because the intervening networks are undefined and that the voicemail rarely receives the CLI and thus cannot identify the voice channel as originating with the legitimate voicemail user. When Joong et al sends the voice mail message it must indicate the subscriber identification which implies to examiner that both a signaling and voice connection are established.

Specification

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 – 7, 9 – 22, 24 – 30, 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Joong et al (U.S. Patent No. 6,188,887).

Referring to claim 1, Joong et al teaches a system for providing a roaming subscriber with access to services available in a first telephone network via a telephone connection (Column 3, Lines 1- 4), said subscriber roaming in a second telephone network (Figure 1), the system comprising: a first service node for association with said first telephone network (Figure 1; 30), a second service node for association with said second mobile telephone network (Figure 1; 30), a packet-switch network for connecting said first service node with said second service node (Figure 1; 50 and Column 8, Lines 46-58), said first and said second service nodes being configured to establish said telephone connection from said roaming mobile subscriber to a requested one of said services in said first mobile telephone network (Column 1, Lines 6-12) and to exchange signals required for said services between said first mobile network and said second telephone network (Column 2, Lines 48-64) via said packet switch network (Figure 1; 50 and Column 8, Lines 46-58) thereby to support said substantially seamless access, said signals comprising at least a subscriber identification signal to be transferred from said first telephone network and said second telephone network via said packet-switch network with said telephone connection (Column 1, Lines 6-12 and Figure 1).

Referring to claim 17, Joong et al teaches a system for providing a roaming subscriber at a remote telephone network with access to services available in a first telephone network (Column 3, Lines 1- 4), the method comprising the steps of: attaching a first node to said first

telephone network, wherein a second node is connected to said remote telephone network (Figure 1) and making a voice and signaling connection between said first and said second node using a packet switch network (Column 1, Lines 6-12 and Column 8, Lines 46-58), thereby to support transfer of a subscriber identifying signal between said roaming subscriber and at least one of services located at said first telephone network together with a voice connection to said services (Column 2, Lines 48-64), thereby to render said at least one of said services available with voice operation to said roaming subscriber (Column 1, Lines 6-12).

Referring to claim 7, Joong et al further teaches wherein said first service node is configured for transmitting said signals between said first telephone network and said packet-switch network; and said second service node is configured for transmitting said signals between said packet-switch network and said second telephone network (Figure 1; 30, 50 and Column 3, Line 49).

Referring to claims 2, 3, 18, and 19, Joong et al further teaches wherein network is one of a group including: a mobile telephone network, a fixed telephone network, a Global System for Mobile communications (GSM) network, a Time Division Multiple Access (TDMA) network, a Code Division Multiple Access (CDMA) network, an IS-41 network, and a private branch exchange (PBX) (Figure 1).

Referring to claims 4 and 20, Joong et al further teaches a passive System Signaling Number 7 (SS7) monitor for monitoring SS7 signals and triggering the provision of access to at

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least one of said services when one of a group of predetermined SS7 signals has been detected (Column 8, Lines 46-51).

Referring to claims 5 and 21, Joong et al further teaches wherein said predetermined SS7 signals are Mobile Application Part (MAP) messages (Column 8, Line 51). MAP messages are a part of SS7 for mobile phones, therefore when discussing SS7 is essentially the same as discussing MAP messages when in a mobile environment

Referring to claims 6 and 22, Joong et al further teaches wherein said messages are from a group including: short messages and location updates (Column 8, Lines 49-50).

Referring to claim 7, Joong et al further teaches wherein said first service node is configured for transmitting said signals between said first telephone network and said packet-switch network; and said second service node is configured for transmitting said signals between said packet-switch network and said second telephone network (Figure 1; 30, 50 and Column 3, Line 49).

Referring to claims 9 and 24, Joong et al further teaches wherein said subscriber uses a short code dependent upon the location of said subscriber to access said second service node (Column 3, Lines 47-50 and (Column 9, Lines 25-30). The message could be sent to either the first or second node.

Referring to claim 10, Joong et al further teaches wherein said first service node instructs said second service node via said packet switch network to generate and send a short message (Column 8, Lines 46-58).

Referring to claims 11 and 25, Joong et al further teaches a user profile of said subscriber, said user profile comprising at least a subscriber calling line identification (CLI) wherein said subscriber CLI is required for access to said services (Column 9, Lines 25-30).

Referring to claims 12 and 26, Joong et al further teaches wherein said second service node receives said subscriber CLI from DTMF-signals-sent by said subscriber (Column 9, Lines 25-30).

Referring to claims 13 and 27, Joong et al further teaches wherein said second service node receives a second CLI from said second telephone network and said second CLI is associated with said subscriber CLI (Column 9, Lines 25-30).

Referring to claims 14 and 28, Joong et al further teaches wherein said second service node creates a voice path connecting said second telephone network with said first telephone network using a second CLI of said second service node, and wherein said first service node replaces said second CLI with said subscriber CLI when accessing one of said services (Column 9, Lines 25-30).

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Referring to claims 15 and 29, Joong et al further teaches wherein said services include voice message notification (Column 3, Lines 12-14).

Referring to claims 16 and 30, Joong et al further teaches wherein said services include voice message retrieval (Column 3, Lines 12-14).

Referring to claim 31, Joong et al further teaches wherein said subscriber is enabled to use a short code dependent on the location of said subscriber to access said second service node (Column 9, Lines 25-30).

Referring to claim 32, Joong et al further teaches wherein said first service node is operable to instruct said second service node via said packet-switch network to generate and send a short message (Column 1, Line 11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8 and 23 are rejected under 35 USC 103(a) as being unpatentable over Joong et al and further in view of Comer (U.S. Patent No. 5,588,042).

Referring to claims 8 and 23. Joong et al further teaches the limitations of claims 8 and 23, but does not teach wherein said second service node transmits dial tone multi-frequency (DTMF) signals substantially concurrently with the creation of a voice path connecting said first telephone network with said second telephone network, and said first service node synchronizes said DTMF signals with said voice path. Comer teaches wherein said second service node transmits dial tone multi-frequency (DTMF) signals substantially concurrently with the creation of a voice path connecting said first telephone network with said second telephone network, and said first service node synchronizes said DTMF signals with said voice path (Column 9, Lines 14-42). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Joong et al with the art of Comer of wherein said second service node transmits dial tone multi-frequency (DTMF) signals substantially concurrently with the creation of a voice path connecting said first telephone network with said second telephone network, and said first service node synchronizes said DTMF signals with said voice path to receive touch tone responses from customers as inputs (Column 9, Lines 15-16).

7. Claims 33, 34 and 35 are rejected under 35 USC 103(a) as being unpatentable over Joong et al and further in view of Brown et al. (U.S. Patent No. 5,668,875).

Referring to claims 33, 34 and 35, Joong et al further teaches wherein network is one of a group including: a mobile telephone network, a fixed telephone network, a Global System for Mobile communications (GSM) network, a Time Division Multiple Access (TDMA) network, a Code Division Multiple Access (CDMA) network, an IS-41 network, and a private branch

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exchange (PBX) (Figure 1), but does not teach wherein said second mobile telephone network comprises any other group and is not a GSM network. Brown et al. teaches wherein said second mobile telephone network comprises any other group and is not a GSM network (Column 5, Lines 15-18). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Joong et al with the teaching of Brown et al. wherein said second mobile telephone network comprises any other group and is not a GSM network to provide a subscriber roaming out of his home system authentication in a system using a different authentication protocol (Column 5, Lines 10-13).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Agre U.S. Patent No. 5,978,679 discloses coexisting GSM and CDMA wireless telecommunications networks.

Spartz et al. U.S. Patent No. 6,178,337 discloses wireless telecommunications system utilizing CDMA radio frequency signal modulation in conjunction with the GSM A-interface telecommunications network protocol.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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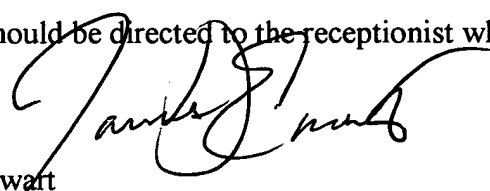
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D Ewart whose telephone number is (703) 305-4826. The examiner can normally be reached on M-F 7am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703)308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-9508 for regular communications and (703)305-9508 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.


Ewart
December 22, 2003


WILLIAM TROST
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